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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,376	02/27/2002	Daisuke Miyakoshi	112066	4770
25944	7590	03/30/2006	EXAMINER	
OLIFF & BERRIDGE, PLC			TO, TUAN C	
P.O. BOX 19928			ART UNIT	
ALEXANDRIA, VA 22320			PAPER NUMBER	

3663

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/083,376	MIYAKOSHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tuan C. To	3663	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-8,10-12,22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10-12,22 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2, 4-6, 10-12, 22, and 23 are rejected under 35 U.S.C. 102(a) as being anticipated by Bates et al. (US 20010055974A1).

With respect to claim 1, Bates et al. directs to a system/method for selectively ringing one or more lane phones or portable telephones based on the geographic position of a portable phone. In the patent, there is a portable telephone (100) (Bates et al, figure 1), including a position detector (220) as similar as the claimed receiver unit, provided for determining the geographic position of the portable phone; and the microphone (150) as a data obtaining device; the memory (230), which is the claimed storage unit, is the combination of volatile memory and non-volatile memory for storing location information (geographic region) and parameters to go along with each geographic location. Bates et al. disclose “the data being correlated with last location information received by the receive unit, and when received location information is different from last received location information, extracting data on the current received location information from among data stored in the storage unit”. It is truth because the mentioned storage unit (230) stores the location data and correlates the data with the received location information received from the unit (220) (Bates et al, page 3,

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paragraph 0036). When a user who is carrying the portable telephone to a new location that is different from the location information, the data that relates to that location is retrieved. Bates et al. further teaches a display (130) that notifies the user the information indicative of geographic location stored in the portable phone. Thus, Bates et al. further discloses the limitation: "an information notification unit to notify the user of the portable information terminal of information corresponding to the extracted data. As set forth in page 3, paragraph 0041, the phone display prompts for boundary points of the region before requiring further input when the user is located in a specific region. The boundary points are clearly the extracted data prompted via the phone display without requiring the user's instruction. Therefore, Bates et al. also read on "information extracted from the extracted data without any instruction made by the user'.

With regard to claim 2, the reference to Bates et al. further discloses the storage unit (230) that stores and correlates data and location information received by the unit (220). In figure 2, the keypad (120) is ready for use to instruct the data storing in the storage unit (230).

With respect to claim 4, the position detector (220) as represented herein is the claimed receive unit for receiving location information; the memory (230) is the claimed storage unit. A user uses one of the keys of key pad (120) to instruct the storage unit to store data. The storage unit (230) correlates and stores the data (telephone parameters) and location information received by the position detector unit (220).

With respect to claim 5, the keypad (120) represented above herein includes a variety of keys for user to select either a location information or data from different pre-

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stored location information, and data stored in the memory (230) (page 2, paragraphs 0032, 0034). The storage unit (230), as illustrated in Bates et al, stores and correlates the data and the geographic region select by the user (Bates et al, page 3, paragraphs 0035, 0036).

With regard to claim 6, figure 1 of Bates et al. shows that the notification unit includes the display (130), and speaker (140). Therefore, the teachings of Bates et al. read on the limitation "wherein the information notification unit is a liquid crystal display for displaying an image corresponding to the data, or is a speaker for outputting sound corresponding to the data.

With regard to claims 10-12, the position detector (220) is illustrated in Bates et al. as a GPS receiver, and that the location information is obtained based on a signal received by said the position detector (220) (Figure 1; page 3, paragraphs 0036, 0037).

With regard to claim 22, the microphone (150) disclosed in Bates et al. is considered as the data obtaining device as claimed.

With regard to claim 23, as represented herein above, the memory (230) is the claimed storage unit, and that the combination of volatile memory and non-volatile memory for storing location information (geographic region) and parameters to go along with each geographic location. The keypad (120) represented above herein includes a variety of keys for user to select either a location information or data from different pre-stored location information, and data stored in the memory (230) (page 2, paragraphs 0032, 0034). The position detector (220) is the claimed receive unit, which is provided for determining the geographic position of the portable phone. Bates et al. further teach

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the following: the storage unit (230) that stores the location data and correlates the data with the received location information received from the unit (220) (Bates et al, page 3, paragraph 0036). When a user who carrying the portable telephone to a new location that is different from the location information, the data belongs to that location would be retrieved. Bates et al. also disclose a display (130) for notifying a user of the information the data that belongs to a geographic location that has been stored in the portable telephone. Thus, Bates et al. additionally discloses the limitation: "an information notification unit to notify a user of the portable information terminal of information corresponding to the extracted data. In addition, the microphone (150) is considered as the data obtaining device as claimed in the present invention.

The statements of intended use or field of use, "for receiving...", "for obtaining...", "for storing...", "for prompting...", "for correlating...", "for displaying...", "wherein..." clauses (see claims 1, 2, 4-6, and 23) are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates et al. (US 20010055974A1) and in view of Stewart (US 6049718A).

With respect to claims 7 and 8, Bates et al. explicitly disclose the limitations of claims 1 and 4 except for that “the location information is a base station code of a base station with which the portable information terminal is communicating”.

The US reference to Stewart, as represented herein, discloses a portable telephone comprising: a storage (50) for storing location code, which is the base station code of a base station as claimed in the present invention.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Bates et al. to include the teachings as taught by Stewart so that the location data of a base station is generated correspondingly from the base station code which station is communicating to a portable telephone.

### ***Response to arguments***

The applicant argues in his response, “Bates does disclose the display 130 affirmatively notifies a user of a change of location information and, therefore, does not disclose every element of claims 1 and 23”. It should be noted that the display (130) is a part of the mobile terminal (100) to display output to a user about a change in location. As set forth in page 3, paragraph 0041, the display of the mobile terminal first prompts for boundary points of the region. Next, the user then goes to a boundary point and presses a key on the phone to store the boundary point. Therefore, before the user activate a key to record the boundary points, the display of the mobile device



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clearly notifies the user the boundary points showing the change in location information.

The applicant argues that Bates system does not correlate data and location information in a storage unit of a portable information terminal. The argument's is not persuasive because the correlate data is disclosed in Bates as the phone parameters. Each geographic region has its own parameters and said parameters are independent of the phone parameters of other region. When a geographic region is defined, the phone parameters set for that region are retrieved.

For that reason, the claims are still rejected.

### ***Conclusions***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan C To whose telephone number is (571) 272-6985. The examiner can normally be reached on from 8:00AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/tc

March 23, 2006

  
JACK KEITH  
SUPERVISORY PATENT EXAMINER